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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,698	11/24/2003	Jonah Harley	10030475-1	7442

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL 429
Intellectual Property Administration
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Loveland, CO 80537-0599

EXAMINER

NGUYEN, JENNIFER T

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,698	Applicant(s) HARLEY ET AL.	
	Examiner Jennifer T. Nguyen	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-10 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-24 of copending Application No. US 2005/0110755. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

US 2005/0110755 (claim 1)	US 2005/0110754
a pointing device,	a pointing device (claim 1)
a surface having a puck field of motion defined thereon	a moveable puck confined to move within a puck field of motion (claim 1)
a moveable puck comprising a user sensor that detects an interaction between a user and said puck, said puck being confined to move within said puck field of motion	the moveable puck includes a user sensor that detects the interaction of a user and said puck (claim 2)

a position detector that measures the position of said puck in said puck field of motion.	a position detector (18) that measures the position of said puck in said puck field of motion (claim 1)
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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherriff et al. (GB 2247938) in view of Burrett (Patent No.: US 5,615,083).

Regarding claim 1, Sherriff teaches a pointing device (figs. 6-8) comprising:

a puck sub-assembly (20) comprising:

a moveable puck (20) confined to move within a puck field of motion (fig. 7); and

a support member (31) having an opening therein that determines a boundary for said puck field of motion (page 9, lines 9-28);

a base sub-assembly (12, fig. 1) comprising:

a base surface (12) over which said puck moves (10, fig. 1-3); and

a position detector (18) that measures the position of said puck in said puck field of motion (page 8, lines 25-36);

Sherriff differs from claim 1 in that he does not specifically teach “an attachment mechanism ...said base assembly”.

Burrett teaches an attachment mechanism (col. 5, lines 5-45) for connecting a base sub-assembly (112) to said puck sub-assembly (150) such that said puck sub-assembly is reversibly separable from said base assembly, and said base surface is accessible when said puck sub-assembly is separated from said base assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the attachment mechanism as taught by Burrett in the system of Sherriff in order to provide a pointing device with a stable electrical connection is achieved and easily to maintain a clean environment for the device.

Regarding claim 2, Sherriff teaches the moveable puck includes a user sensor that detects the interaction of a user and said puck (page 3, line 34 to page 4, line 4).

Regarding claim 3, the combination of Sherriff and Burrett teaches the puck sub-assembly is separable from said base sub-assembly without the use of tools (col. 5, lines 5-45 of Burrett).

Regarding claims 4 and 5, Sherriff teaches a restoring mechanism (30) that returns said puck to a predetermined area in said puck field of motion (page 9, lines 21-25).

Regarding claim 6, the combination of Sherriff and Burrett teaches the support member further comprises a first contact (connecting point 154 on the bracket 152 to the collar 117) that mates with a corresponding second contact (connecting point on the collar 117 to the bracket 152) in said base sub-assembly for making an electrical connection between said puck and said base sub-assembly (col. 5, lines 5-23).

Regarding claim 7, the combination of Sherriff and Burrett teaches the puck is electrically connected to said first contact (154) through a spring that returns said puck to a predetermined area in said puck field of motion (col. 5, lines 5-23).

Regarding claim 8, Sherriff teaches said position sensor comprises a plurality of surface electrodes (18, fig. 5) on said surface and a puck electrode (17, fig. 4) that moves with said puck (page 9, lines 1-7).

Regarding claims 9 and 10, Sherriff teaches said base sub-assembly is integral with a portable host apparatus (see abstract).

5. The prior art made of record and not relied upon is considered to pertinent applicant's disclosure: US 6,326,948 and US 5,504,502.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer T. Nguyen whose telephone number is 571-272-7696. The examiner can normally be reached on Mon-Fri: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 10/722,698

Page 6

Art Unit: 2629

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Nguyen
7/20/06

A handwritten signature in black ink, appearing to read 'R. Hjerpe', with a stylized, cursive script.

RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600